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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,825	08/17/2000	Danuvio Carrion	05725.0346-1	2723

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EXAMINER
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HOWARD, SHARON LEE

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/582,825

Applicant(s)

CARRION ET AL.

Examiner

Sharon L. Howard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Claims 1,15,17-22 have been amended

Claim 7 has been cancelled therein.

Claims 1-6,8-24 are pending.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6,14,20,21,23,24 remain rejected under 35 U.S.C. 102(b) as being anticipated by Pappas (U.S. Patent No. 5,093,108).

Pappas teaches a quick drying nail enamel composition and a method for coating the nails, thereby achieving favorable properties such as gloss and durability (see abstract). Pappas teaches that the nail enamel composition primary film forming polymers (e.g. nitrocellulose, cellulose acetate, ethyl cellulose, vinyl polymers, acrylate type polymers) and a secondary or additional film forming polymers comprising alkyd resins and acrylic and methacrylic resins (col.9, lines 13-68). Pappas teaches compositions which may be used as base coats or top coats for application to the nails (col.9, lines 6-8). Pappas also teaches a plasticizer (col.10, lines 1-33), a thixotropic agent (col.13, lines 30-42), coloring agents or pigments (col.12, lines 65-68) consisting of D & C red No. 7, titanium dioxide, yellow and red iron oxides, chromide oxide greens (col.13, lines 1-13). Pappas teaches that the pigments comprise 2% to about 5% of pigment particles (col.13, lines 48-53). Pappas teaches that the particles are milled to

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about 5 microns (col. 13, lines 42-45). Pappas also teaches solvents, such as ethyl and methyl acetate, pentane, hexane and methylene chloride (col. 10, lines 10-31), which reads on cosmetically acceptable medium. The prior meets the claims of applicants.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-14, 20, 21, 23, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pappas ('108). Pappas is discussed above. Pappas does not particularly teach microspheres. However, although Pappas does not particularly teach microspheres, Pappas suggest the teachings of microspheres. Pappas teaches pigment particles which are milled to about 5 microns, milled particles include spheres some microspheres would be present. ( col.13, lines 42-45). The expected result would be a nail enamel composition comprising pigment particles, a film forming polymer, in a cosmetically acceptable homogeneous medium.

3. It would have been obvious to one or ordinary skill in the art at the time the invention was made to use the teachings of Pappas. One having ordinary skill in the art would have been motivated to prepare the composition of Pappas, because Pappas teaches a composition which is easy to apply and useful for the purpose of coating the nails, that would dry to a smooth, strong aesthetically acceptable nail coating film.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pappas ('108) in view of Ellingson et al. (U.S. Patent No. 5,965,111).

Pappas is applied above.

Pappas does not specifically teach applying a nail enamel top coat.

However, Ellingson teaches fast drying nail polish compositions which are known in the art for having improved wear properties (see abstract). Ellingson teaches a method of applying a basecoat to the nails (col.6, lines 65-67, bridging col.7, lines 1-13) and a method of applying a topcoat (col.8, lines 33-48). Ellingson teaches that the topcoat compositions comprises pigments and dyes (col.9, lines 30-33). Ellingson also teaches film forming polymers (col.8, lines 49-67, col.9, lines 13) and solvents (col.9, lines 14-19) which read on a cosmetically acceptable medium.

The expected result would be a quick drying nail enamel composition comprising in a cosmetically acceptable medium, pigment particles, a film forming polymer, as well as other conventional ingredients which are known in nail enamel compositions.

It would have been within the skill of the ordinary practitioner at the time the invention was made to use the composition taught by Pappas, because Pappas teaches a quick drying nail enamel composition comprising film forming polymers, pigment

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particles, and solvents, in the composition taught by Ellingson, with expectation of achieving a nail enamel composition comprising a solvent, pigment particles and a film former polymer.

Claims 15-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellingson ('111) in combination with Schlossman (U.S. Patent No. 5,356,617).

Ellingson is applied above.

Ellingson does not teach microspheres.

However, Schlossman teaches pigment-material-microsphere complexes which are known in nail enamels (see abstract). Schlossman teaches both organic and inorganic microspheres which can be hollow, solid or porous or mixtures thereof (col.6, lines 65-67). Schlossman teaches that the microspherical powders are known to have diameters from 1 to 100 microns (col.6, lines 66-68, col.7, lines 1-8)

The expected result would be a fast drying nail polish composition comprising a base coat composition, a topcoat, as well as film forming polymers, a solvent and microspheres.

It would have been within the skill of the ordinary practitioner at the time the time the invention was made to use the fast drying nail polish composition taught by Ellingson, in the composition taught by Schlossman, because Schlossman teaches microspheres which are known in nail enamels and one would expect similar results.

### ***Response to Arguments***

Applicant's arguments filed 12/3/03 have been fully considered but they are not persuasive. Applicant argues that Pappas' discussion regarding particle size of about 5

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microns refers to a particular thixotropic agent, stearalkonium hectorite, and not to pigments at all. Stearalkonium hectorite is not a ceramic, a polymer, or a metal, and thus does not and cannot be considered to encompass the microspheres as presently claimed. Ellingson, like Pappas fails to teach or suggest uncoated ceramic microspheres, uncoated polymeric microspheres, and uncoated metal microspheres. Nowhere else does Pappas discuss particles or microspheres, and does not provide any motivation or suggestion to modify this reference to include microspheres. Nowhere does Schlossman teach or suggest uncoated microspheres according to the present invention.

In response to applicants' arguments, Pappas teaches pigment particles such as carbon black or lampblack (see col.13, lines 12 and 13). Carbon black contain pigment particles and since the pigment particles are equivalent they would inherently have the same properties as applicants. Therefore, Pappas teaches the same composition.

Applicant does not provide no criticality in the amounts in the generic claim.

Schlossman '617 teaches hollow microspheres and complex microspheres which are uncoated pigments (see col.8, lines 43-46). See Tables 1 and 2 at col.7, for teaching of microspheres. While the microsphere may have pigment they comprise pigment particles, and the basic shape of the microsphere is maintained. The rejections are therefore maintained for reasons of record.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Howard whose telephone number is (703) 308-4359. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-3121 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

*Sharon Howard*  
*April 1, 2004*

*James M. Spear*  
JAMES M. SPEAR  
PRIMARY EXAMINER  
*AU 1615*